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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,884	06/07/2005	Marc Andre Peters	NL021348	7221

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EXAMINER
RAAB, CHRISTOPHER J

ART UNIT	PAPER NUMBER
2166	

MAIL DATE	DELIVERY MODE
01/23/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Office Action Summary	Application No. 10/537,884	Applicant(s) PETERS ET AL.
		Examiner Christopher J. Raab	Art Unit 2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 June 2005*.

2a)☐ This action is FINAL. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *07 June 2005* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date *06/07/05*.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

Information Disclosure Statement

01.   The information disclosure statement (IDS) filed on **06/07/05** has been

considered by the examiner and made of record in the application file.

Priority

02.   Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which

papers have been placed of record in the file.

Drawings

03.   The drawings are objected to under 37 CFR 1.83(a) because they do not contain

labels. Any structural detail that is essential for a proper understanding of the disclosed

invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing

sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to

avoid abandonment of the application. Any amended replacement drawing sheet should

include all of the figures appearing on the immediate prior version of the sheet, even if

only one figure is being amended. The figure or figure number of an amended drawing

should not be labeled as "amended." If a drawing figure is to be canceled, the

appropriate figure must be removed from the replacement sheet, and where necessary,

the remaining figures must be renumbered and appropriate changes made to the brief

description of the several views of the drawings for consistency. Additional replacement

sheets may be necessary to show the renumbering of the remaining figures. Each

drawing sheet submitted after the filing date of an application must be labeled in the top

margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If

the changes are not accepted by the examiner, the applicant will be notified and

informed of any required corrective action in the next Office action. The objection to the

drawings will not be held in abeyance.

Claim Objections

04.   The claims are objected to because they contain unnecessary capitalized words.

For example, in claim 1, Submitting, Forming, Searching, and Returning need not be

capitalized. Appropriate correction is required.

05.   **Claim 10** is objected to under 37 CFR 1.75 as being a substantial duplicate of

claim 5. When two claims in an application are duplicates or else are so close in

content that they both cover the same thing, despite a slight difference in wording, it is

proper after allowing one claim to object to the other as being a substantial duplicate of

the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 101

06.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or
> composition of matter, or any new and useful improvement thereof, may obtain a patent therefor,
> subject to the conditions and requirements of this title.

07.   **Claims 12 and 14** are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter. The claims lack the necessary

physical articles or objects to constitute a machine or a manufacture within the meaning

of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are

they a combination of chemical compounds to be a composition of matter. As such,

they fail to fall within a statutory category. They are, at best, function descriptive

material *per se*.

Descriptive material can be characterized as either "functional descriptive

material" or "nonfunctional descriptive material." Both types of "descriptive material" are

nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d

at 1759. When functional descriptive material is recorded on some computer-readable

medium, it becomes structurally and functionally interrelated to the medium and will be

statutory in most cases since use of technology permits the function of the descriptive

material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d

1031, 1035 (Fed. Cir. 1994).

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on

a computer-readable medium, in a computer, or on an electromagnetic carrier signal,

does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that

the claims for an algorithm in *Benson* were unpatentable as abstract ideas because

"[t]he sole practical application of the algorithm was in connection with the programming

of a general purpose computer.").

Claim Rejections - 35 USC § 102

08.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

> (e) the invention was described in (1) an application for patent, published under section 122(b),
> by another filed in the United States before the invention by the applicant for patent or (2) a
> patent granted on an application for patent by another filed in the United States before the
> invention by the applicant for patent, except that an international application filed under the treaty
> defined in section 351(a) shall have the effects for purposes of this subsection of an application
> filed in the United States only if the international application designated the United States and
> was published under Article 21(2) of such treaty in the English language.

09.   **Claims 1 – 14** are rejected under 35 U.S.C. 102(b) as being unpatentable over

Faybishenko, Yaroslav et al. (WO 02/091242), hereinafter "Faybishenko".

Consider **claim 1**, Faybishenko discloses a method of allowing peers to connect

to each other, each storing information (read as method of searching data in a peer to

peer network connecting peers, wherein peers are enabled to store data objects

received from a data source) (abstract, Figures 1,5), comprising:

receiving search requests from peers (read as submitting a search query from a

first peer) (page 2 lines 2 – 13, page 4 lines 32 – 40) ;

using the search query information to create a network between peers (read as

forming a private network with at least one further peer connected to the peer to peer

network, the further peer satisfying at least one criterion determined by the first peer)

(page 2 lines 2 – 13, 29 – 37);

searching for the query and returning results that match the query submitted by

the consumer (read as searching for data objects stored by peers connected by the

private network, the data matching the search query and returning the result of the

search executed in the previous step to the first peer) (page 2 lines 9 – 13, 19 – 29).

Consider **claim 2**, and **as applied to claim 1 above**, Faybishenko discloses a

method such that the peers can subscribe to specific providers, and that the data from

the query can be sent to the requesting peer through a delivery service (read as peers

are enabled to subscribe to at least one data delivery service and to store data objects

received from the data delivery service and the criterion is subscription to at least one

deliver service to which the first peer is subscribed as well) (page 2 lines 19 – 24, lines

33 – 40, page 4 lines 16 – 27, page 6 lines 26 – 37).

Consider **claim 3**, and **as applied to claim 1 above**, Faybishenko discloses a

method such that the query the consumer submits can be used to find providers that are

registered to respond to that query (read as the criterion is derived from the search

query and the private network is formed after submission of the search query) (page 2

lines 19 – 24, page 4 lines 16 – 27).

Consider **claim 4**, and **as applied to claim 2 above**, Faybishenko discloses a

method such that the peer network created can be one such as Napster or Gnutella

(read as the data delivery service is a broadcast service provider and the data objects

are streams of audio-visual data) (page 4 lines 16 – 27).

Consider **claim 5**, and **as applied to claim 1 above**, Faybishenko discloses a

method such that data searched for can have metadata associated with it, such that the

metadata can be used to find data that matches the submitted query (read as the data

objects have meta-data associated with them and the step of searching for data objects

comprises analysis of the meta-data) (page 5 lines 7 – 16, page 7 lines 3 – 12).

Consider **claim 6**, and **as applied to claim 5 above**, Faybishenko discloses a

method such that metadata contains a content identifier (read as the meta-data

comprises a content reference identifier) (page 42 lines 18 – 29).

Consider **claim 7**, and **as applied to claim 6 above**, Faybishenko discloses a

method such that content identifier can be used to find other content referred through

advertisements (read as the content reference identifier points to a further document

and the method comprises the step of searching the further document for the search

query) (page 42 lines 18 – 29, page 45 lines 19 – 33).

Consider **claim 8**, and **as applied to claim 2 above**, Faybishenko discloses a

method such that the peers can subscribe to specific providers, and that the data from

the query can be sent to the requesting peer through a subscribed provider (read as the

result of the search only comprises data objects that match the query and that have

been received from at least one content delivery service the first peer is subscribed to

(page 2 lines 19 – 24, lines 33 – 40, page 4 lines 16 – 27, page 6 lines 26 – 37).

Consider **claim 9**, and **as applied to claim 8 above**, Faybishenko discloses a

method such that data searched for can have metadata associated with it, such that the

metadata can be used to find data that matches the submitted query (read as the data

objects have meta-data associated with them and information on the content delivery

service that has delivered a data object can be derived from the meta-data associated

with the data object) (page 5 lines 7 – 16, page 7 lines 3 – 12, page 45 lines 19 – 34, Figures 15, 18).

Consider **claim 10**, and **as applied to claim 1 above**, Faybishenko discloses a method such that data searched for can have metadata associated with it, such that the metadata can be used to find data that matches the submitted query (read as the data objects comprise meta-data and the step of searching for data comprises the step of analysing the meta-data) (page 5 lines 7 – 16, page 7 lines 3 – 12).

Consider **claim 11**, and **as applied to claim 1 above**, Faybishenko discloses a method such that the peers can comprise a peer-to-peer network (read as the data source is a Peers of the peer to peer network) (page 4 lines 32 – 40).

Consider **claim 12**, Faybishenko discloses any type of computing system for performing the method of claim 1 (read as computer being programmed to perform the method according to claim 1) (page 5 lines 40 – 42).

Consider **claim 13**, Faybishenko discloses an apparatus for allowing peers to connect to each other, each storing information (read as apparatus for searching data in a peer to peer network connecting peers, a storage device to store the data objects an a central processing units) (abstract, Figures 1,5), comprising:

receiving search requests from peers (read as a receiver unit for receiving data objects from a data source) (page 2 lines 2 – 13, page 4 lines 32 – 40) ;

using the search query information to create a network between peers (read as form a private network with at least one further peer connected to the peer to peer

network, the further peer satisfying at least one criterion determined by the apparatus) (page 2 lines 2 – 13, 29 – 37);

searching for the query and returning results that match the query submitted by the consumer (read as submit a search query to the private network, receive results from the further peer, the results matching the query) (page 2 lines 9 – 13, 19 – 29).

Consider **claim 14**, Faybishenko discloses any type of computing system for performing the method of claim 1 (read as computer programme product for programming a computer enabling the computer to perform the method according to claim 1) (page 5 lines 40 – 42).

Conclusion

10.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

        a) Kuno, Harumi Anne et al.   US PGPub   2003/0182270

        b) Kakivaya, GopalaKrishna Reddy et al.   US PGPub   2004/0201600

11.   Any response to this Office Action should be **faxed to** (571) 273-8300 **or mailed to**:

        Commissioner for Patents
        P.O. Box 1450
        Alexandria, VA 22313-1450

        Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

12.   Any inquiry concerning this communication or earlier communications from the

Examiner should be directed to Christopher Raab whose telephone number is (571)

270-1090. The Examiner can normally be reached on Monday-Friday from 8:30am to

6:00pm.

        If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's

supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for

the organization where this application or proceeding is assigned is (571) 273-8300.

        Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

        Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist/customer service whose telephone

number is (571) 272-2600.

Christopher Raab
C.R./cr

January 21, 2008

HOSAIN ALAM
SUPERVISORY PATENT EXAMINER